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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/762,893	02/13/2001	Ursula Schindler	02481.1734	1265

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EXAMINER
FORD, JOHN M

ART UNIT	PAPER NUMBER
1624	7

DATE MAILED: 03/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/762,993	Schindler
Examiner	**Group Art Unit**
J. M. Ford	1634

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on January 16, 2002.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1--8, 10--15 and 17--23 is/are pending in the application.

Of the above claim(s) 11, 12, 18, 19 and 23 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1--8, 10, 13-15, 17 and 20--22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☒ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

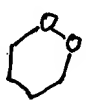
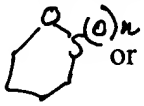
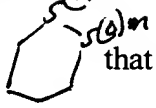
☐ Other _____

Office Action Summary

Applicants response of January 16, 2002, is noted.

The claims in the application are claims 1--8, 10--15 and 17--23.

Claim 1 is rejected under 35 U.S.C. 112, 1st and 2nd paragraph.

Note R1 may a heterocyclic ring that is  or  or  that is not believed to exist.

Adjacent O/S, O/O or S/S combination are notoriously unstable. What is the source of the starting materials?

It is not believed proper to preempt work of others, who may, in the future, be able to change the bond angles, such that the compounds could be made, only to find out others had already claimed this newly producible ring.

This problem repeats throughout the claim, i.e. R2. Heteroaryl, on page 5 of the most recent response, is not allowable as it recites one or more hetero atoms. This claims a hugh number of compounds that would require specific conception by the reader. There rings would dwarf the pyrimidine of formula I, and control the classification and search, elsewhere.

What is the purpose of the proviso statement or page 5 of the most recent response? Is art being written around? See new Rule 105; 37 CFR 105.

In re Nomiya, 184 USPQ 607, provides that there is no reason not to conclude that the species removed by exception are in the prior art, and reject in view of those species.

The next adjacent compound would be structurally obvious. See, In re Dillion, 919 F.2d at 696, 16 U.S.P.Q. 2d at 1904. See also Deuel, 51 F.3d at 1558, 34 U.S.P.Q. 2d at 1214

('Structural relationships may provide the requisite motivation or suggestion to modify one compound to obtain another compounds. For example, one compound may suggest its homologs, because homologs often have similar properties, and, therefore, chemists of ordinary skill would ordinary contemplate making then to try to obtain compounds with improved properties, or merely to satisfy their production goals.

Other structural similarities have been found to support a prima facie case of obviousness. E.g., In re May, 574 F.2d 1082, 1093-95, 197 U.S.P.Q. 610-11 (CCPA 1978) (stereo isomers); In re Wilder, 563 F.2d 457, 460, 195 U.S.P.Q. 426, 429 (CCPA 1977) (adjacent homologs and structural isomers); in re Hoch, 428 F.2d 1341, 1344, 166 U.S.P.Q. 406, 408 (CCPA 1970) (acid and ethyl ester); IN re Druey, 319 F.2d 237, 240, 138 U.S.P.Q. 38, 41 (CCPA 1963) (omission of methyl group from pyrazole ring).

A compound need not be a homolog or isomer of a prior art compound in order to be susceptible to a rejection based on structural obviousness.

Thus, a difluorinated compound was held unpatentable over the prior art dichloride compound on the basis of analogical reasoning. Ex parte Wiseman (POBA 1953) 98 U.S.P.Q. 277.

Accordingly, claim 1 is rejected under 35 U.S.C. 103, as being unpatentable over the compounds removed by exception at the end of claim 1, the next adjacent compounds, to those removed, would be structurally obvious from the those compounds removed.

Claims 2--8 are rejected as being dependent on a rejected claim.

Claims 10 and 17 are rejected under 35 U.S.C. 112, 1st and 2nd paragraph as those claims do not indicate their intended use, and the specification obviously could not support all uses.

A method of activating soluble guanylate cyclase is not a real world utility and does not comply with the Utility Guideline. Applicants were requested to elect one real world utility, as required by the Rules. See Rule 475.

MPEP 806.05(h) provides that under those circumstances where applicants claims allege more than one utility, they, the claims, may be held withdrawn altogether. Accordingly, claims 11, 12, 18, 19 and 23 stand withdrawn under 37 CFR 1.499, as they are directed to more than one utility. Applicants may elect one.

The form of claims 20--22 is noted. Are applicants electing the utility of claim 22?

Claim 22 is rejected for the reasons claim 1 was rejected.

Claims 13--15 and 20--21 are rejected as being dependent on a rejected claim. They could not be allowed as they would contain rejected portions if they were written in independent form.

Claim 15 is an obvious process of producing compounds of claim 5 that is the same process of claim 8. Claim 15 is rejected as a duplicate of claim 8. The process itself is what is being claimed, and is identical.

The vague nature of activating 4-hydroxy pyrimidine in claim 8 could include converting the hydroxy to a chloro as noted on page 84 of EP 055693, of record. The reaction of the resulting

(activated) compound with a nitrogen containing compound with the elimination of HCl, is shown on page 27 of WO 98/37079, of record.

Therefore, claims 8 and 15 are rejected as obvious under 35 U.S.C. 103.

J. Ford:jmr

March 7,2002

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